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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,280	03/06/2002	Aristides Franca Neto	71364-0002	5590

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EXAMINER

LEE, DIANE I

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,280

Applicant(s)

NETO, ARISTIDES FRANCA

Examiner

D. I. Lee

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 02 June 2004. Claims 1, 3-5, 11-12, and 14-15 have been amended; claim 18 has been canceled; and no claims have been newly added. Currently, claims 1-17 and 19 are pending in this application.

2. In claims 1, 11, and 14-15 of the Amendment filed 02 June 2004, the applicant correctly identified the status of the claims. However, it is noted by the examiner that some of the added features in claims 1, 11, and 15 (i.e., “a mans for notifying a user that the allocated amount of time is about to expire” in claim 1, “a mans for notifying a user that an amount of time for connection to said global computer network is about to expire” in claim 11, “said amount of time” in claims 14, and “providing a notification to the user when said allocated predetermined amount of time is about to expire” in claim 15) were not correctly underlined. The Applicant's cooperation is requested in reviewing and correcting the claims.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

4. Applicant requested the Examiner to acknowledge receipt of one (1) Replacement Sheet of formal drawings of the Figure (see page 2 of the Amendment filed 02 June 2004). However, the examiner finds no record of the Replacement Sheet of formal drawings of the Figure in the application. Please

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toader et al. [US 5,749,075-referred as Toader, previously cited by the Examiner].**

Toader discloses a card (not specifically shown) with information thereon, comprising:

a plurality of information including:

a toll free telephone number along with instruction thereon capable of being used to connect a computer device to an Internet service provider via a telephone connection and a global computer network (see col. 2, lines 55+ and col. 5, lines 28+);

a code (PIN account number which is an alpha-numeric symbol), wherein said code can be used as a password for enabling said computer device to be connected to said global computer network, and providing access to an account of predetermined credited allotted time associated with the code (see col. 2, lines 55+; col. 3, lines 1+; and col. 6, lines 40+); and

a predetermined amount of Internet access time (i.e., indicating the amount of time that has been allocated to said account), wherein the time allocated to the account determines how long the computer can remain connected to said global computer network (see col. 2, lines 55+; col. 3, lines 1+).

Although Toader teaches providing a notification that the amount of time is expired (i.e., once the prepaid time period is up, the system prompts the user with options for extending the access period (i.e., the system notifies the user that allocated amount of time has expired by prompting the user with options

for extending the access period, see col. 3, lines 45+); Toader does not give the notification when the amount of time is about to expire.

However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide the notification prior to the amount of time is expired such that user have greater time to make a decision in extending the access period. Accordingly, it would have been an obvious extension taught by Toader.

7. **Claims 1, 8-10, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toader in view of Tomer [US 4,717,815, newly cited by the Examiner].** The teachings of Toader have been discussed above

Re claims 1 and 8-10: Although Toader teaches that once the prepaid time period is up, the system notifies the user that allocated amount of time has expired by prompting the user with options for extending the access period (see col. 3, lines 45+); Toader does not disclose the notifying means is included in the card, i.e., the card having a means for notifying a user that the allocated amount of time is about to expire.

Tomer discloses a pre-paid card having a time storage device for storing a usable pre-purchased time period and a time measuring device. The time measuring device includes a display and decrementing means for decrementing the pre-purchased time storage device and to display the time in the pre-purchased time storage device (see col. 1, lines 40+; col. 4, lines 1+; and figure 1).

In view of Tomer's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the time storage device, the time measuring device, and the decrementing means for indicating the decrement of the pre-purchased time on the card so as to visually notify the user status of the time used on the card, thus the user is aware of the allocated amount

of time is about to expire, so that user have greater time to make a decision in extending the access period.

Accordingly, it would have been an obvious extension taught by Toader.

Re claim 16: Toader teaches the method of providing multiple cards and each having a different PIN account code (see abstract lined 1-3).

Re claim 19: wherein the predetermined amount of time allocated to the account can be adjusted (see col. 6, lines 40+).

8. **Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toader as modified by Tomer as applied to claim 1 above, and further in view of Tarbutton et al. [US 2001/0037209 A1].** The teachings of Toader as modified by Tomer have been discussed above.

Although Toader teaches that card include instructions on getting Internet access software, which is related information regarding the Internet service provider; and the fact that applicant has not explicitly define what is connective identification, the instruction providing the related information regarding the Internet service provider (i.e., the Internet access software associated with the specific Internet provider would also have to identify the specific identity of the type of the domain sponsor) would also include connective identification; Toader as modified by Tomer is silent with respect to the specifics of the card having connective identification.

Tarbutton teaches a prepaid card provided with a connective identification, i.e., a website address and an e-mail (see par. 21)

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to explicitly provide detail information regarding the connective identification information in order to provide a card with the comprehensive data regarding the type of the Internet service provider and/or the type of the domain sponsor.

9. **Claims 4-7, 11-14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toader as modified by Tomer as applied to claim 1 above, and further in view of Thompson et al. [US 2004/001164-referred as Thompson].** The teachings of Toader as modified by Tomer have been discussed above.

Re claims 4-6 and 11-14: Toader as modified by Tomer fails to disclose the card having a removable protective cover provided to conceal the information on the code.

Thompson teaches a pre-paid card having a removable protective cover (i.e., a layer of removable scrape paint) provided to conceal the information on the access code 22 (see par. 20 and figure 1) and wherein the layer of removable scrape paint obviously encompasses the scratch-off paint, other scratch-off material, and a peel-off paint.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide a layer of removable scrape paint as a removable protective cover in order to protect the access code from unauthorized user.

Re claim 7: Toader as modified by Tomer fails to teach one or more removable protective covers provided to conceal the information on the plurality of portion.

Thompson teaches a pre-paid card having a plurality of removable protective covers to conceal the plurality of information (see par. 20 and figure 1).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide a plurality of removable protective covers to conceal the information on the plurality portions of information that provide an Internet access to unauthorized user. Such modification would further restrict the access to the Internet to the fraudulent users.

Re claim 17: Toader teaches the prepaid card for multiple purpose, i.e., for accessing limited Internet time and for time limited long distance calls, each having predetermined amount of time allocated thereto, e.g., while the Internet access can be for 1 or 2 hours and a long distance time period could be 30 minutes, respectively.

Toader as modified by Tomer does not teach the card having multiple access codes assigned to different accounts.

Thompson teaches a pre-paid card having a plurality of access codes (figure 1).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teaching of Thompson of single card having a multiple access code in the teaching of Toader as modified by Tomer to provide multiple access code each having predetermined amount of time allocated thereto in order to provide a card with multiple independent pre-paid function, i.e., the user can utilize the card with long distance call as well as accessing Internet.

Response to Arguments

10. Applicant's arguments filed 6/2/04 with respect to newly cited limitation "a notification means" have been fully considered but they are not persuasive and/or moot in view of the new ground(s) of rejection.

11. Applicant argued that neither Toader, Tarbutton et al., nor Thompson et al teaches or suggest s **means for notifying a user than an amount of time for connection to the global computer network is about to expire** (see page 9, lines 18+ of the applicant's response filed 6/2/04). The newly added feature, i.e., a **means** for notifying the user in the card, is taught by Tomer (see the rejection above). It is noted by the examiner that in method claim 15, the specific recitation of "*providing a notification to the user when said allocated predetermined amount of time is about to expire*" does not limit which device of the

system is providing the notification. It is known to have a system automatically informing the user about the remaining balance is about to expire in the user's account, and is commonly practiced (see Kwan [US 2003/0200179], Stimson [US 6,502,745], Lesley [US 6,333,976], and Knoll [US 5,570,416] for example). Since Toader teaches the system notifying the user that allocated amount of time has expired by prompting the user with options for extending the access period (i.e., once the prepaid time period is up, the system prompts the user with options for extending the access period, see col. 3, lines 45+), it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide the notification prior to the amount of time is expired such that user have greater time to make a decision in extending the access period. Accordingly, it would have been an obvious extension taught by Toader.

12. *In response to applicants' argument* that the Examiner's conclusion of obviousness for the 35 USC §103(a) rejection fails to establish a *prima facie* case of obviousness, the Examiner respectfully disagrees. In contrary to the Applicants' statement, all the rejections under 35 USC §103(a) in the prior and the instant Office Action established a *prima facie* case of obviousness meeting the three basic criteria of the M.P.E.P. 2143.03 (8th ed. 2001). See the Office Action mailed on March 2, 2004.

Furthermore, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has clearly pointed out rationale for appropriate combination of the references. Thus, the Applicants' argument on this point is not persuasive.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Clapper [US 2002/0080941], Higashi [US 5,262,376] discloses a pre-paid card having a displaying means for indicating the remaining balance of the card.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. I. Lee
Primary Examiner
Art Unit 2876

D. L.